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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/802,797
Filing Date: March 09, 2001
Appellant(s): RANDALL WHITTEN ET AL.

MAILED
AUG 22 2007
GROUP 3700

Daniel T. McGinnity
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/11/2007 appealing from the Office action mailed 11/13/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,599,194 Smith et al. 4-1999

Getting Started Windows98, 2nd Ed., Microsoft Corporation, [June 25, 1998], pp. 80-81
and 87-90

Links 386CD, 1995, Access Software, Inc., pp. 1-87

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 18, 20-25, 27-35, 57, 58, 60, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Microsoft®Windows98.

Smith et al. discloses a home video game console system that is modified to include additional communication and storage capability via a modem and hard disk drive. Additionally, Smith et al. discloses it is contemplated that the enhanced video game console system may alternatively be packaged in a common integrated housing and sold as a single unit. Smith et al. discloses:

Regarding Claims 22, 25, and 57:

- A game console (52) comprising a hard disk drive (206) that is non-removable from the game console and that stores a console application (file(s)) to which the game console boots that presents a graphical user interface providing navigation to media on the game console, wherein the hard disk drive is segregated into a user data region and an application data region (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

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Regarding Claim 58:

- including a portable media drive (CD ROM) coupled to a processor and configured to communicate with a storage disc upon which the media is stored (Column 4, lines 23-25).

Regarding Claims 20-24 and 28-31:

- the non-removable hard disk drive is configured to store data associated with multiple saved games (Column 7, lines 34-42).

Regarding Claim 60:

- the game console comprising an enclosure for the processor (100), the non-removable hard disk drive (206) and a port (80a-d) for interfacing with a game controller (56a-d) (Column 3, lines 41-46 and Figure 1A).

Regarding Claims 18 and 57:

- A game console (52) comprising a processor (100) and a hard disk drive (206) coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive (partitioned hard disk drive) stores application data such that data associated with a first application is inaccessible to other applications (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

Regarding Claims 27, 34, and 57:

- identifying a game identifier (file name or program on the hard disk drive) associated with a video game installed in a game console, wherein the game

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console contains a hard disk drive (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);

- determining portions of the hard disk drive that are associated with the video game based on the game identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22). Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and
- preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

Regarding Claim 35:

- one or more computer-readable media (hard disk drive 206 or CD ROM) comprising computer-executable instructions that, when executed, perform the method as recited in claim 27 (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 69:

- an input port for receiving input from a controller (80a-d) operable by a player to generate video game control signals (Column 3, lines 41-46 and Figure 1A);

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- an output port (176) for outputting a display of three-dimensional video game play graphics for a television (Audio/Video Out, Figure 1C, Figure 3);
- a processor (100) for executing instructions of a video game program (Figure 2);
- a controller system (56a-d) coupled to said input port (80a-d) and to said processor (100) for executing commands related to the video game control signals (Figures 1A and 2);
- a portable media reader (CD ROM) for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media (Column 4, lines 23-25); and
- a fixed disk in a non-removable hard disk drive (206) in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42), wherein;
- upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for the game console (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42); and
- the processor executes instructions that are read from the selected media (Game CD or game program data downloaded from the Internet) by the portable media reader (Column 4, lines 23-25).

Regarding Claim 70:

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- the processor will not boot without initially loading the initial program read from the fixed disk by the hard disk drive (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42). Inherently, the system has a boot sequence that requires that a program be read. In this case, that file can be located directly on the hard drive (Column 3, lines 53-56); and
- the initial program is initially loaded from the hard disk drive upon booting the processor such that, prior to the portable media reader reading media containing video game instructions, a display containing the prompt is output to the output port (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

Regarding Claim 71:

- identifying an identifier (file name or program on the hard disk drive) associated with the media (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);
- determining portions of the hard disk drive that are associated with the identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22) Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and
- preventing access to portions of the hard disk drive that are not associated with the identifier. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program

is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

Although Smith et al. does not appear to explicitly disclose a hard disk drive having a user data region and an application region; a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications; and preventing the video game from accessing portions of the hard disk drive that are not associated with the video game Microsoft®Windows98 teaches these features.

It would have been obvious at the time of applicant's invention to utilize the advance file management techniques taught in Microsoft®Windows98 in order to partition a hard disk drive into separate application regions and to make certain files inaccessible to other applications in the video game. One would be motivated to do such that game data from different video games would be placed in a particular location on a hard drive such that game data and application data would be stored on the hard disk drive in an organized manner (pp. 80-81 and 87-90).

2. Claims 26, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Microsoft®Windows98 and further in view of Links 386CD Players Manual.

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Smith et al. in view of Microsoft®Windows98 teaches to one having ordinary skill in the art that as discussed above regarding Claims 18, 20-25, 27-35, 57, 58, 60, d 69-71.

However, the combination seems to lack explicitly disclosing everything except:

Regarding Claims 11 and 26:

- the non-removable hard disk drive is configured to store a list of recently used nicknames.

Regarding Claims 32, 33, 36, and 38:

- retrieving a list of recently used nicknames associated with the video game installed on the game console.

Regarding Claims 39 and 40:

- allowing the user of the game console to create a new nickname.

Regarding Claim 41:

- automatically entering the selected nickname into a high score display.

Links 386CD Players Manual discloses golf video game played on a game console (personal computer) having a hard disk drive and memory. Links 386CD Players Manual, Smith et al., and Microsoft®Windows98 are analogous art because each relate to a game system/computer to play video games. Furthermore, Links 386CD Players Manual teaches:

Regarding Claims 11, 26, 32, 33, 36, 38, 39, and 40:

- retrieving, displaying, and allowing a user of the gaming system to select and/or create a nickname (player name) from/in the Player List Box (Page 19).

Regarding Claim 41:

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- automatically entering the selected nickname into a high score display (score card) (Page 28).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Links 386CD Players Manual nickname feature in Smith et al. in view of Microsoft®Windows98. One would be motivated to do so because this is an easy and fun way to distinguish (via an identifier) between each player's game data making the setup and creation of new and existing games simple to the game user.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-18, 20-36, 38-42, 57-58, 60-67, and 69-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,716,102. Although the conflicting claims are not identical, they are not patentably distinct from each other because to one having ordinary skill in the art at

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the time of applicant's invention, booting a computer into a graphical user interface upon powering up was notoriously well known.

(10) Response to Argument

Regarding claim 18, Appellant's arguments are as follows:

1. The purposed combination lacks all the recited features of the claims.
2. The combination is impermissibly based on hindsight.
3. The combination lacks proper motivation.

The Examiner respectfully disagrees with the arguments for the following reasons:

1. The combination does in fact teach the claimed limitations of a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The citation of pages 80 and 81 are to indicate that the teachings of Microsoft®Windows98 pertain to that of a computer with a disk drive as well as provide teachings for the partitioning of drives. While the second part of the excerpt (pages 87-90) from Microsoft®Windows98 are cited to teach a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The citation provides teachings for allowing users the ability to restrict access to files, folders or printers; not only printers as alleged by Appellant (pages 87-90). A user profile may be considered an application because upon boot-up or login

the profile accesses certain files and folders related to the profile and therefore when a file or folder (application data) is designated to be restricted from a particular profile or all profiles (applications) except for one, it can be said to be inaccessible to other applications; thus the teachings are provided by the of Microsoft®Windows98.

2. The references are analogous art because they both teach systems with hard disks drives and the teachings provided by of Microsoft®Windows98 would prevent errors by preventing undesired alteration of certain files and folders and to maintain an organized hard disk system which would have been obvious to one of ordinary skill in the art at the time of invention.

When constructing or creating a gaming system like that of Smith (Smith 4:1-5), one of ordinary skill in the art would obvious look towards means to manage systems with large data capacities upwards of a gigabyte (Smith 4:1-5) such as that of Microsoft®Windows98 (page 80) for teachings to better improve the system and therefore it would not be considered hindsight.

3. Appellant states that because Smith cites no need for an alteration or problem in which its data is stored in an unorganized manner such that it would benefit from the teachings of Microsoft®Windows98. The Examiner respectfully disagrees. There is no such requirement for the formulation of a proper 103 wherein there must be some explicit need recited by the prior art. Rather, the Examiner has relied on the common knowledge of one of

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ordinary skill in the art at the time of invention to provide the proper motivation for the combination as discussed in greater detail in the preceding paragraph.

4. Appellant further states that the motivation of combining Smith with Microsoft®Windows98 is too general and is akin to making the invention more efficient. The examiner respectfully disagrees. Improved organization and error prevention, although it does improve efficiency, is not too general and are not akin to a blanket statement of improved efficiency. Instead the motivational statement describes specific ways in which the combination would improve efficiency, through improved organization and error prevention as stated in the current rejection.

Regarding claims 20-25, 27-35, 57, 58, 60 and 69-71:

Appellant argues the same points as discussed in claim 18 and the claims are not allowable for the reasons as stated above.

Further regarding claim 22:

Appellant states that Smith does not teach a game console having a hard disk drive that has “a first data region to store user data” and “a second region to store application data” as recited by claim 22. The Examiner respectfully disagrees. The expansion hard drive can be used to download full games (application data) or used for various other purposes as exercised by the user: video download, audio download,

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email or chat, all of which is considered (user data) (3:40-46 and 54-67). Therefore the hard disk drive storing such information in respective data blocks can be said to be segregated in that no block of information can be used for more than one purpose at a time.

Furthermore, the segregation as taught by Microsoft®Windows98 for specific profiles means that the user data (a specific user profile and application) is segregated under a different profile as that of the gaming data and therefore their respective files are segregated from one another wherein the game applications/profiles cannot access the user data and vice versa.

Appellant further states that preventing a video game from accessing portions of the hard disk drive that are not associated with the video game is different from the video game not accessing portions of the game and therefore the prior art does not meet the claimed limitations. As discussed in great detail above (response to claim 18), the combination of Smith in view of Microsoft®Windows98 would read on the claimed limitations as the restriction of access and privacy settings taught by Microsoft®Windows98 are applied to the game access of Smith wherein the access of certain data regions may be restricted to specific applications.

Further regarding claims 27 and 57:

Appellant argues that the prior art does not meet the claimed limitations in the prevention of the video game accessing portions of the hard disk drive that are not associated with the video game. The Examiner respectfully disagrees. As stated in the response to claims 18 and 22, the prior art does meet the claimed limitations.

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Regarding claim 69:

Appellant alleges that the prior art fails to disclose the processor not booting without initially loading the initial program read from the fixed disk. The examiner respectfully disagrees. The prior art does in fact meet the claimed limitations for the following reasons:

1. In order for any electronic gaming system to boot, a processor needs operating instructions. Since the device of Smith is intended to be an addition to a gaming system, such instructions for boot detection would not be in the gaming system or game cartridge, but rather in the hard drive which includes instructions for booting the machine with respect to the hard drive and game cartridges. Appellant cites 3:51-56 of Smith and argues that because Smith discloses that the game system may start under the control of the cartridge or the hard drive, which it does not require the hard drive to boot and is a teaching away from the claimed subject matter. The examiner respectfully disagrees. As previously stated, the hard drive system of Smith inherently must have a boot sequence that checks for the presence of a cartridge and the hard drive and indicates to the processor which instructions to follow, the instructions not being the boot sequence but rather a program such as a game in a cartridge or that of the hard drive. The cited passage does not pertain to the boot sequence but rather the instructions or programs, the boot sequence is an inherent feature in all systems with processors that indicates to the

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processor which of the instructions or programs to follow upon startup.

Without such instructions, the processor would be unable to determine which set of instructions is to be accepted (in this case, between that of the hard drive or the cartridge) and therefore would not function. In order for the device of Smith to even function there must therefore be a boot sequence to indicate to the processor that the cartridge is to be run instead of the game resident in the hard drive or to run the system from the hard drive when there is no cartridge present. Since the game system and cartridge are independent devices (3:35-38) they cannot anticipate the hard drive addition and cannot have such boot instructions and therefore the only logical place for the boot instructions to be located is in the hard drive since the hard drive is intended as an add-on (3:47-48).

Further regarding claims 70 and 71:

The claims are not allowable for the same reasons as stated for claim 69.

Please refer to the response above.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dat Nguyen, August 17, 2007

Conferees:


Nathan J. Newhouse

Robert Pezzuto

Dat Nguyen

